



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,844	12/29/2000	Rudolf Singer	1382	6713

7590 03/13/2003

Striker Striker & Stenby
103 East Neck Road
Huntington, NY 11743

EXAMINER

VINCENT, SEAN E

ART UNIT PAPER NUMBER

1731

DATE MAILED: 03/13/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/720,844

Applicant(s)

SINGER ET AL.

Examiner

Sean E Vincent

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _ .
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-18 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claims 1-18 are indefinite because the reference numbers confuse the scope of the claims. The claims should stand on their own and not rely on the drawings for clarification or limitations.
4. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.
5. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd.

App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 2 recites the broad recitation “nickel wrought alloy”, and the claim also recites “material no. 2.4816” which is the narrower statement of the range/limitation.

6. Furthermore, claim 2 is indefinite because “material no. 2.4816” is not descriptive of an alloy or a material, but suggests a trade name or index which may change meaning over time. the phrase should be deleted from the claim.
7. Claim 3 is indefinite because the phrase “with the least possible inclination to adhere to the glass” suggests that only one material would satisfy the limitations of the claim while the single material remains unnamed.
8. Claim 4 is indefinite because it reads as though three different PtAu5 material variants would satisfy the claim: PtAu5 alloy, pure PtAu5, or oxide-dispersed PtAu5, although the context and the specification would suggest that the latter two options are meant to be variants of “PtAu5 alloy”. The claim would benefit greatly from proper Markush group language.
9. Claim 6 is indefinite because it contains a parenthetical expression “(hipped)” which should be unnecessary if the rest of the claim were clear and definite. “(hipped)” should be deleted.
10. Claim 13 recites the limitation “the hot conductor” in line 4. There is insufficient antecedent basis for this limitation in the claim.
11. Claim 18 is indefinite because the claim improperly defines a process since the word “use” does not describe a process, *Ex parte Dunki*, 153 U.S.P.Q. 678. If claim 18 is intended to

Art Unit: 1731

be a method claim, it should be presented in positive step action format with each method step acting on the product of the previous method step.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 1, 3-5, 7, 15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ostendarp et al (US 5987923) in view of Kamii et al (US 4023391).

15. Ostendarp et al teaches processes and apparatus for creating structures on flat glass using a driven, ceramic rolling cylinder (base tool) covered with a metal shaping sheet made of "chrome-nickel-steel or platinum-gold alloy" or a steel strip with an anti-stick layer, the cylinder being cooled internally by "known means" and the shaping sheet being heated by lasers, inductive heating or resistive heating (see figures; col. 3, lines 49-56; col. 5, line 4 to col. 6, line

Art Unit: 1731

30; col. 7, lines 38 to 45; col. 8, lines 46 to 67). Ostendarp et al does not disclose that the resistance heater is between a metal hollow cylinder and a shaft with additional thermal insulation from the shaft. Kamii et al teaches internally heated rollers in which resistance heating elements are incorporated within the rolls and connected to a controlled power source using a slip-ring assembly (see figures 1, 2 and 21 and col. 5, lines 1-34 as well as col. 12, lines 20-51). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the internal heating element of Kamii et al as the resistance heating of Ostendarp et al because Kamii et al taught that the temperature distribution along the axis of the roll could be controlled with the pitch of the coiled heating element.

16. Kamii et al does not disclose a heating element located around a shaft and separated therefrom by insulation. It is noted that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In the present case, Ostendarp et al clearly desires to have an internally cooled ceramic roller and to only heat the forming sheet. While Kamii et al only teaches a heating element at the center of a roll, that heating element is disclosed to be a resistance coil. It is the position of the examiner that the combined teachings of Ostendarp et al and Kamii et al would have suggested locating the internal heating element close to the forming sheet to allow for the interior of the roller to be a cooled ceramic structure. This would have required only that the disclosed coils of Kamii et al

Art Unit: 1731

be coiled around the ceramic 'base tool' of Ostendarp et al which would have been the insulation. The claimed shaft reads on the roller axis (10) of Ostendarp et al.

Conclusion

17. The prior art made of record and not relied upon is cited to further show the state of the art.
18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean E Vincent whose telephone number is 703-305-3607. The examiner can normally be reached on M - F (8:30 - 6:00) Second Monday Off.
19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P Griffin can be reached on 703-308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.
20. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



Sean E Vincent
Primary Examiner
Art Unit 1731

S Vincent
March 8, 2003